

Application No. 09/152,992
Amendment dated May 24, 2006 and Resubmitted May 31, 2006
Reply to Office Action of April 24, 2006 and Notice of May 26, 2006

REMARKS

The undersigned and applicant thank the patent examiner for the telephonic interview conducted last week.

In the office action, Claims 1-8 and 12 have been rejected as unpatentable over a combination of Woodley US Patent No. 5,782,672 and Morrissey et al US Patent No. 5,394,889. Also in the action, Claims 14 and 16-20 have been rejected as unpatentable over a combination of Woodley, Morrissey et al and Lee. These rejections are respectfully traversed and further overcome by the above amendments.

In a preferred embodiment, the invention provides a nipple cover having the following attributes:

- i. it covers the nipple and areola;
- ii. (it is a fashion accessory which) works and is used without a brassiere;
- iii. it has a shell;
- iv. it tapers from a first thickness at the center to a small thickness at the periphery;
- v. it has "a curvature of the outer surface of the shell is a substantially smooth continuous one directional curvature from the center to the periphery thereof";
and
- vi. "the shell having a shape of substantially a hollow hemisphere."

These attributes are recited in claim 1 and provide for a cover which smoothly blends with an existing woman's breast, and thus appears natural.

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In the past, fashion models have used band aids to cover the nipples when wearing sheer clothing. The band aids tend to crinkle and are not smoothly tapered.

The Woodley patent discloses a device that looks like a **circular band aid**. It just covers the nipple and areola. When worn it will not have a smooth one directional curve, and it does not have such a curve even when not worn. There is a definite change in thickness at the outer edges where the adhesive layer is located. In any event, the device is substantially flat. It is not a hollow substantially hemispherical curve; does not have a "shell," and will still take the shape of the nipple, but just enlarge and soften it a little.

The Morrissey patent is a newly cited patent that and is for preventing lactation by applying pressure to the nipple. It is plastic. **It has an inward bump or protrusion with which to apply pressure to the breast when worn in a brassiere.** The shell and protrusion must be rigid, because the protrusion must be pressed against the nipple for the device to work.

It would not have been obvious to combine the teachings of Woodley and Morrissey to achieve the claimed invention. There are some important reasons why one would NOT use Morrissey's shape in Woodley's device:

ONE OF ORDINARY SKILL WOULD NOT COMBINE WOODLEY AND MORRISSEY BECAUSE THEY ARE FOR DIFFERENT PURPOSES:

Morrissey's purpose is to push on the nipple N (see Fig. 7) in order to stop lactation. The pressure comes from putting Morrissey's device 3, 7 inside a bra 11 (see Fig. 7). There is a pad 9 between the protrusion 7 and the nipple N. That pad 9 is held in place by the pressure from protrusion 7 and by the inside of the shell or support 2 (FIGs 1

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and 7) confining the pad. The shell has to be significantly bigger than the nipple N and protrusion to help hold the protrusion 7 against the nipple. If it is not, it would be very easy for the device to essentially topple over by the shell 2 slipping inside the bra 11. The shell helps avoid this slippage and also helps distribute the force between the bra 11 and the device.

By contrast, Woodley is like a band aid. It is supposed to be comfortable, not for purposes of applying pressure. It is very supple and not rigid. **Using a rigid shell made to be worn with a brassiere and apply pressure to the nipple for stopping lactation in the device of Woodley which is very flexible and for covering a nipple when no brassiere is worn would not have been obvious to one of ordinary skill in the art.**

Morrissey's device is NOT a replacement for a bra and is NOT something worn to avoid wearing a bra. Morrissey's device is shaped and structured to be worn with a bra (see Fig. 7 and col. 3, lines 33-45, e.g., "The amount of pressure need not be great and can normally be produced by the force provided when apparatus 1 further comprises a brassiere 11.") Woodley's device is for purposes of covering just the nipple and areola. (Col. 2, lines 27-28: "The present invention is a nipple pad for protecting and covering the nipple and areola of a woman's breast.") Woodley's purpose is to provide a device that is worn without a bra. ("It is another object of the invention to provide the user an alternative to using a traditional brassiere by tastefully concealing the nipples." (Col. 2, lines 49-51) These purposes are diametrically opposed. Morrissey's device would NOT work without a bra or something that can push on it. Morrissey's device has to have the hollow shape and curve so that the bra will fit over it smoothly and apply pressure

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evenly. **Woodley would have no reason to take any teachings from Morrissey, whose device is for use with a bra, when Woodley's device is for use without a bra.**

Re Claim 2:

In claim 2, it is recited that "the shell of the nipple cover consists essentially of the flexible material." Morrissey's shell is rigid. If it is not rigid, the device would not be able to apply pressure to the nipple. By contrast, Woodley's device is so flexible that it takes the shape of whatever it covers, like a band aid. It would not have been obvious to use a rigid shell in the device of Woodley.

Re Claim 3:

In claim 3, it is recited that the shell "is of a size configured to be substantially larger than a woman's nipple and areola." Woodley's device is sized only to cover the areola and nipple. If it were any larger, the crinkling effect of a band aid would destroy any aesthetic look, which the device tries to achieve. Accordingly, it would not have been obvious to make the device of Woodley substantially larger than a woman's nipple and areola.

NOT HALF A BREAST:

Re Claim 4:

In Claim 4, it is recited that the said nipple cover is of a size configured for covering at least about one half of a woman's breast and less than the whole breast. This size is definitely not shown in Woodley, and would not have been obvious to achieve, for at least the reasons set forth above with respect to claim 3.

Woodley's device would not be enlarged to cover half a breast. It is meant as simply a nipple cover for when you do not wear a bra. If you enlarge it, it would be

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harder to keep it on the breast and harder to keep it from having (unsightly) folds as anyone who has tried to put a large hand aid on a curved surface such as an elbow or knee knows. Therefore, even if Woodley took the concept of using a hollow curved shape from Morrissey et al, that device would be no bigger than a typical areola.

Claim 19: RUBBER-LIKE MATERIAL:

Claim 19 recites that the device comprises a rubber-like material. A rubber material rebounds or reforms into its original shape after being deformed, like when you squeeze a rubber ball it is deformed, but when you release the ball, it returns to its original shape. Plastic is generally not nearly as elastic as rubber.

CLAIMS TO A KIT

The Lee patent has been recited for teaching custom tinting of a prosthetic device to the skin color of a user. The claims that are like a "kit" i.e., multiple sets of breast covers that have different sizes and/or colors, would not have been obvious by modifying a combination of Woodley and Morrissey further in view of Lee.

Lee is used for a prosthetic intended to be seen and worn all the time, including but not limited to inside a bra. In such a case, custom tinting makes sense. By contrast, the device according to the claimed invention is for going underneath a garment and for being removed when the garment is removed. It is not for putting underneath a bra. It is not for enhancement purposes or replacement of a breast. Therefore, having a selection of colors would not have been obvious. Moreover, given that Woodley and Morrissey cannot be combined, the combination of Lee therewith is not tenable also.

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SUMMARY

It would not have been obvious to take the more structured shape of Morrissey and modify Woodley that way. Woodley would think it uncomfortable, only for the purpose of applying pressure to the nipple for stopping lactation, and intended for wearing underneath a bra, instead of without a bra.

In view of the above amendments and remarks, reconsideration of the application and allowance of all of the claims are respectfully requested. If any issues remain which can be resolved by a supplemental response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number indicated below.

It is not believed that any additional fees are due; however, in the event of any additional fees are due, the Examiner is authorized to charge the enclosed credit card listed on the enclosed authorization form.

Respectfully submitted,

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Date: May __, 2006

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Encls.

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